

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MICROSOFT CORPORATION and MICROSOFT MOBILE, INC.,  
Petitioners,

v.

GLOBAL TOUCH SOLUTIONS, LLC,  
Patent Owner.

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Case IPR2015-01148  
Patent 7,498,749

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**PETITIONERS' RESPONSE TO PATENT OWNER'S MOTION FOR  
OBSERVATION ON CROSS EXAMINATION OF PETITIONER'S REPLY  
WITNESS DR. MARK HORENSTEIN**

Patent Owner's entire Motion for Observation on Cross Examination of Petitioner's Reply Witness Dr. Mark Horenstein should be disregarded because rather than provide "concise statement[s] of a precisely identified testimony to a precisely identified argument or portion of an exhibit," as the rules require, Patent Owner's Motion instead "raise[s] new issues" and "pursue[s] objections," which the rules forbid. Office Patent Trial Practice Guide, 77 Fed. Reg. 157 (August 14, 2012) at 48,768 (noting that an observation "is not an opportunity to raise new issues, re-argue issues, or pursue objections"). Patent Owner's Motion consists of an improper argumentative introduction, followed by observations addressed to entirely new issues or improper objections to Dr. Horenstein's signature and attestation. Therefore, it should be disregarded. *See id*; *see also Atrium Medical Corp. v. Davol*, IPR2013-00184, Paper No. 49 at 2 (February 28, 2014) ("The Board may decline consideration or entry of excessively long or argumentative observations.").

### **Response to Introduction**

**Patent Owner's Introduction to its Observations should be disregarded because it is not an observation, it raises new issues, and it pursues objections.** The Trial Practice Guide explains that each observation should be in the form of "In exhibit \_\_ on page \_\_, lines \_\_, the witness testified \_\_. This testimony is

relevant to the \_\_\_ on page \_\_\_ of \_\_\_. The testimony is relevant because \_\_\_.” 77  
Fed. Reg. 157 at 48,768. Patent Owner’s two-page introduction fails to follow this  
format, and raises new issues and improper objections such as whether Dr.  
Horenstein’s “affixation of a graphic text” was sufficient to sign his declaration.  
IPR2015-01148, Paper No. 24 at 3.<sup>1</sup> Thus, Patent Owner’s introduction should be  
disregarded. *See* IPR2013-00184, Paper No. 49 at 2.

### **Response to Observation 1**

**Observation 1:** In Exhibit 2007, at 80:5-7, regarding Dr.  
Horenstein’s Second Declaration (Exhibit 1019), Dr. Horenstein  
testified “I think it would be obvious to anyone reading paragraph  
seven that the first instance of number 520 is a typo and should be  
516.” This is relevant to Dr. Horenstein’s credibility and the weight to  
be given to his testimony because Dr. Horenstein did not acknowledge  
this error upon signing the Second Declaration (Exhibit 1019) on June  
1, 2016, or upon re-signing the Second Declaration (Exhibit 2008) on  
June 9, 2016, indicating he did not read either declaration.

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<sup>1</sup> Petitioner addresses the substance of Patent Owner’s objections to Dr.  
Horenstein’s signature and attestation in its response to Patent Owner’s Motion to  
Exclude, which is focused on the same issues.

Patent Owner's Observation 1 should be disregarded because it raises new issues and pursues objections. 77 Fed. Reg. 157 at 48,768. Moreover, contrary to Patent Owner's argument that Dr. Horenstein "did not read either declaration," Dr. Horenstein testified that "of course" he read the declarations prior to signing and that he simply "did not catch the typographical error." Ex. 2007 (Deposition Transcript of Mark Horenstein dated June 28, 2016) at 81:7-16.

### **Response to Observation 2**

**Observation 2:** In Exhibit 2007, at 92:4-6, regarding Dr. Horenstein's Second Declaration (Exhibit 1019), Dr. Horenstein testified "In my mind, this is in context, it is an obvious typographical error that anyone could identify upon reading the document[.]" This is relevant to Dr. Horenstein's credibility and the weight to be given to his testimony because Dr. Horenstein did not acknowledge this error upon signing the Second Declaration (Exhibit 1019) on June 1, 2016, or upon re-signing the Second Declaration (Exhibit 2008) on June 9, 2016, indicating he did not read either declaration.

Patent Owner's Observation 2 should be disregarded because it raises new issues and pursues objections. 77 Fed. Reg. 157 at 48,768. Moreover, contrary to Patent Owner's argument that Dr. Horenstein "did not read either declaration," Dr.

Horenstein testified that “of course” he read the declarations prior to signing and that he simply “did not catch the typographical error.” Ex. 2007 (Deposition Transcript of Mark Horenstein dated June 28, 2016) at 81:7-16.

### **Response to Observation 3**

**Observation 3:** In Exhibit 2007, at 97:21-98:1, regarding whether Dr. Horenstein knew about the error of paragraph 7 of Dr. Horenstein’s Second Declaration (Exhibit 1019) by June 9, 2016, Dr. Horenstein testified “Apparently not because I signed the documents on June 9th with the boiler plate clause added.” This is relevant to Dr. Horenstein’s credibility and the weight to be given to his testimony because Dr. Horenstein did not acknowledge this error upon signing the Second Declaration (Exhibit 1019) on June 1, 2016, or upon re-signing the Second Declaration (Exhibit 2008) on June 9, 2016, indicating he did not read either declaration.

Patent Owner’s Observation 3 should be disregarded because it raises new issues and pursues objections. 77 Fed. Reg. 157 at 48,768. Moreover, contrary to Patent Owner’s argument that Dr. Horenstein “did not read either declaration,” Dr. Horenstein testified that “of course” he read the declarations prior to signing and that he simply “did not catch the typographical error.” Ex. 2007 (Deposition

Transcript of Mark Horenstein dated June 28, 2016) at 81:7-16. Further, Dr. Horenstein testified that he noticed the typographical error while “reviewing the document” in preparation for his deposition. *Id.* at 101:15-102:8.

#### **Response to Observation 4**

**Observation 4:** In Exhibit 2007, at 37:11-12, regarding the jurat added to the Second Declaration (Exhibit 2008), Dr. Horenstein testified that the jurat “to me what appears to be a standard boiler plate paragraph[.]” Similarly, in Exhibit 2007, at 38:2-3; 38:11-16; 97:21-98:1; 104:12-13; 104:18-19; 105:22-106:1; 137:3-4; and 139:21-22, Dr. Horenstein testified that he views the jurat as merely “boiler plate” language. This is relevant to Dr. Horenstein’s credibility and the weight to be given to his testimony because this testimony indicates the lack of meaning given to the jurat by Dr. Horenstein.

Patent Owner’s Observation 4 should be disregarded because it raises new issues and pursues objections. 77 Fed. Reg. 157 at 48,768. Further, contrary to Patent Owner’s argument that Dr. Horenstein’s “testimony indicates the lack of meaning given to the jurat,” Dr. Horenstein testified that even though his original declaration did not include a jurat, “[o]f course [he] wouldn’t sign a document that

[he] didn't testify before or stand behind." Ex. 2007 (Deposition Transcript of Mark Horenstein dated June 28, 2016) at 18:8-9.

**Response to Observation 5**

**Observation 5:** In Exhibit 2007, at 131:10-14, regarding the scope of Patent Owner's expert's testimony, Dr. Horenstein testifies that Patent Owner's expert did not testify about adjusting sensitivity of a touch sensor: "Did he talk about adjusting the sensitivity of the touch sensor in any fashion? MR. MURPHY: Object to form. THE WITNESS: No. In paragraph four I offer the remedy of adjusting the sensitivity." This is relevant to the timeliness of the arguments presented in at least paragraph 4 of Dr. Horenstein's Second Declaration (Exhibit 1019).

Patent Owner's Observation 5 should be disregarded because it raises new issues and pursues objections. 77 Fed. Reg. 157 at 48,768. Moreover, while Patent Owner argues that Dr. Horenstein's argument regarding adjusting sensitivity of the touch sensor is not timely, Dr. Horenstein testified that "the sensitivity is one of three possible remedies that addresses the use brought up by Dr. Morley [of inadvertent animate actuation]." Ex. 2007 (Deposition Transcript of Mark Horenstein dated June 28, 2016) at 11:19:8-132:3; *see also* 133:3-8 ("I was

addressing something asserted by Dr. Morley . . . Inadvertent actuation by animate objects.”).

### **Response to Observation 6**

**Observation 6:** In Exhibit 2007, at 133:8, regarding the portions of the record to which paragraph 4 of Dr. Horenstein’s Second Declaration responds, Dr. Horenstein testifies “Inadvertent actuation by animate objects.” This is relevant to the timeliness of the arguments presented in at least paragraph 4 of Dr. Horenstein’s Second Declaration (Exhibit 1019) because inadvertent actuation by animate objects was previously addressed in Dr. Horenstein’s First Declaration (Exhibit 1012 at ¶42) without discussion of adjusting sensitivity of a touch sensor.

Patent Owner’s Observation 6 should be disregarded because it raises new issues and pursues objections. 77 Fed. Reg. 157 at 48,768. As indicated in relation to Observation 5, while Patent Owner argues that Dr. Horenstein’s argument regarding adjusting sensitivity of the touch sensor is not timely, Dr. Horenstein testified that “the sensitivity is one of three possible remedies that addresses the use brought up by Dr. Morley [of inadvertent animate actuation].” Ex. 2007 (Deposition Transcript of Mark Horenstein dated June 28, 2016) at



11:19:8-132:3; *see also* 133:3-8 (“I was addressing something asserted by Dr. Morley . . . Inadvertent actuation by animate objects.”).

Dated: July 13, 2016

Respectfully submitted,

/Daniel J. Goettle/

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**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that true and correct copies of the foregoing **PETITIONERS' RESPONSE TO PATENT OWNER'S MOTION FOR OBSERVATION ON CROSS EXAMINATION OF PETITIONER'S REPLY WITNESS DR. MARK HORENSTEIN** was served via email this 13<sup>th</sup> day of July, 2016, on the following:

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